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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/851,218	05/08/2001	Per Hellberg	P/1318-121	3172
2352	7590	03/31/2005	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			LANIER, BENJAMIN E	
			ART UNIT	PAPER NUMBER
			2132	
DATE MAILED: 03/31/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/851,218

Applicant(s)

HELLBERG ET AL.

Examiner

Benjamin E Lanier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment file 28 February 2005 amends claims 1, 4, and cancels claim 2. Applicant's amendment has been fully considered and is entered.

### ***Response to Arguments***

2. Applicant's arguments filed 28 February 2005 have been fully considered but they are not persuasive. Applicant's argument that Olsen does not teach or suggest an interactive tool that enables a person of a first list to register approval of a license creation and wherein a person of a second list actually implements the change to the license certificate is not persuasive because the requester submits the information that will be used to determine authorization for license certification creation, and the administrator is provided with the capabilities to actually create the license certificate (Col. 5, lines 20-25 & Col. 12, lines 1-6).

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3-12, 14-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Olsen, U.S. Patent No. 5,758,069. Referring to claims 1, 3, 5-12, 14, 15, 18, Olsen discloses an electronic licensing system wherein license certificates are created for a software program upon request by a client for use of that software program (Col. 2, lines 37-54), which meets the limitation of a plurality of license certificates corresponding to a plurality of software products

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which require corresponding ones of the license certificates to enable operation thereof. An executable entity is used to create the license certificates (Abstract & Col. 9, lines 4-21), which meets the limitation of a license certificate creation or modification tool operable to create or modify license certificates. Upon a client request for a license certificate a license certificate object is created that is associated with the client request and the software program (Col. 2, lines 44-60), which meets the limitation of an authorization tool that sets criteria for the creation or modification of license certificates. These license certificate objects are later used to create the executable entities that will ultimately create the licenses (Col. 9, lines 4-21). A license certificate database is used to store license records, each of which contains a license certificate supplied by a vendor or other installer along with additional information like user information (Col. 5, lines 20-25), which meets the limitation of a first list of personnel authorized to use the authorization tool and a granted authorization table. When the license certificate object is created and its information collected, it adjusts the information in the database to reflect the granting of the license (Col. 2, lines 51-54), which meets the limitation of a granted authorization table created by the authorization tool which identifies the criteria. A license service provider is used for performing license transactions and performs several licensing functions including receiving requests from clients and maintaining and searching the license certificate database to create license certificate objects (Col. 3, lines 54-59), which meets the limitation of a controller that enforces compliance in the creation of new or modified license certificates with the criteria in the granted authorization table. To meet the limitation of a second list specifying individuals having access to the license certificate creation or modification tool that is different from the first list, Olsen discloses that the license server that creates the license certificates is run by an

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administrator (Col. 12, lines 1-6). Servers with administrator levels contain a list of authorized user with administrator capabilities, which would be different than the list of authorized users for certain certificates.

Referring to claims 16, 17, Olsen discloses that the license certificate database contains information regarding the users, license handles, ownership information (Col. 4, lines 38-44), vendors, product name, version, and number licensed units (Col. 2, lines 40-43).

Referring to claim 4, Olsen discloses that the users can be an administrator (Col. 1, line 29), which meets the limitation of the individuals in the second list being system programmers.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen, U.S. Patent No. 5,758,069, in view of Snyder, U.S. Patent No. 6,070,171. Referring to claim 13, Olsen discloses an electronic licensing system wherein license certificates are created for a

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software program upon request by a client for use of that software program (Col. 2, lines 37-54), which meets the limitation of a plurality of license certificates corresponding to a plurality of software products which require corresponding ones of the license certificates to enable operation thereof. An executable entity is used to create the license certificates (Abstract & Col. 9, lines 4-21), which meets the limitation of a license certificate creation or modification tool operable to create or modify license certificates. Upon a client request for a license certificate a license certificate object is created that is associated with the client request and the software program (Col. 2, lines 44-60), which meets the limitation of an authorization tool that sets criteria for the creation or modification of license certificates. These license certificate objects are later used to create the executable entities that will ultimately create the licenses (Col. 9, lines 4-21). A license certificate database is used to store license records, each of which contains a license certificate supplied by a vendor or other installer along with additional information like user information (Col. 5, lines 20-25), which meets the limitation of a first list of personnel authorized to use the authorization tool and a granted authorization table. When the license certificate object is created and its information collected, it adjusts the information in the database to reflect the granting of the license (Col. 2, lines 51-54), which meets the limitation of a granted authorization table created by the authorization tool which identifies the criteria. A license service provider is used for performing license transactions and performs several licensing functions including receiving requests from clients and maintaining and searching the license certificate database to create license certificate objects (Col. 3, lines 54-59), which meets the limitation of a controller that enforces compliance in the creation of new or modified license certificates with the criteria in the granted authorization table. Olsen does not disclose that a user

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is rejected license certificates if there has been unauthorized alterations made. Snyder discloses distributed software system wherein the software tracking service utilizes a database to compare user information and software information presented as a token, which would meet the limitation of a certificate, with that stored in the database to determine whether or not the software token presented is authenticate or unauthorized (Col. 2, line 21 – Col. 3, line 7), which would meet the limitation of denying rights to a given user to create or modify license certificates, after the given user has attempted a pre specified number unauthorized modifications. It would have been obvious to one of ordinary skill in the art at the time the invention was made to reject user requests in Olsen based on the unauthorized modification of registration information in order to help curtail unauthorized copying as taught in Snyder (Col. 2, line 21 – Col. 3, line 7).

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin E Lanier whose telephone number is 571-272-3805.

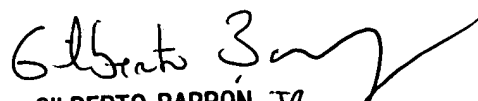
The examiner can normally be reached on M-Th 7:30am-5:00pm, F 7:30am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Benjamin E. Lanier



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